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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 09/905,063 | 07/13/2001 | Jun Watanabe | 450100-03345 | 3458 |
| 20999 | 7590 | 03/05/2008 | | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | EXAMINER BOCCIO, VINCENT F | |
| | | | ART UNIT 2165 | PAPER NUMBER |
| | | | MAIL DATE 03/05/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/905,063

Applicant(s)

WATANABE ET AL.

Examiner

Vincent F. Boccio

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amend & Resp of 12/19/07 & RCE 1/25/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2165.

Response to Arguments

1. Applicant's arguments with respect to amended claims 13-24 have been considered and new ground(s) of rejection have been provided based on the amendment.

{A} In re pages 6-8, applicant states,

"The prior art does not show, "use selection of playback, part of each video or audio in the title is sequentially reproduced";

"Tsumagari *appears to disclose* allowing a user to insert an entry point (bookmark)";

"Rather, Tsumagari ONLY discloses allowing a user to insert a bookmark at an arbitrary recording position." and

"nothing in the combination of references discloses, shows, teaches or suggests sequential reproducing parts of each vide or audio in a title list upon user selection of playback, as claimed in claims 13 and 19."

In response after a careful consideration of the amendment to the claims, which now recite reproducing part of each multimedia section based on the titles and sequential playback of the parts, such as a play-list, but sections of parts of the titles, rather than just a play list of songs or videos {VOBs or titles}.

The examiner directions applicant to examiner the subject matter at various areas Tsumagari which is deemed to anticipates what is stated, to be not disclosed, suggested or taught by any references in the previous rejection.

Tsumagari, @:

Figs. 6, 18, 21, "USER DEFINED PGC", "TEXT",
"TEXT & THUMBNAIL POINTER";

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Fig. 25, "ENTRY POINT", "date";

Fig. 26, Display with GUI, "PG1, PG2" & "Programs & Text"

Wherein Fig. 27, shows:

PARTS OF PROGRAM #1 (two parts 1 & 2) & PROGRAM # 2; and

PARTS OF PROGRAM #3 (two parts 3 & 4), of PLAY LIST #1,

"PROGRAM PARTS THAT FORM A PLAY LIST", col. 4, lines 3-;

Fig. 29, Recording & Reproduction apparatus/device &
record medium (10) and sources (42, 44) etc...

Fig. 35, Display of Titles

- o w/thumbnails,
- o w/Time, Title {is text};
- o ATTRIBUTE (SET & USER);
- o date and times,
- o sorted in date/time order by the system.

Fig. 47, Titles SORTED BY USER, being Parts in a play-list

Based on the above disclosure the examiner fails to agree with the arguments made,

- o Book-marking, by the user AND/OR the system (Fig. 35);
- o Play-list creation, PARTS of titles/Programs (Fig. 27), parts identified by ENTRY POINTS (beginning and Ending);
- o Fig. 35, col. 30, lines 48-56, "SORTED in playback times" as disclosed by Tsumagari.

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After a careful consideration the examiner reads Tsumagari as now anticipating at least the independent claims in view of the amendment to the claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 13-15, 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsumagari et al. (US 6,480,669).

Regarding claims 13 and 19, Tsumagari discloses and meets the limitations associated with a video recording/reproducing method and apparatus capable of recording to a medium and reproducing video from the medium comprising:

- recording video or audio signals and ID signals (see Fig. 27) indicating the content of the video and audio signals, into a recording medium (Fig. 26, PG1 & PG2, Fig. 29, TV tuner, A & V signal);
- list generating a title lists (Figs. 35, 39, 45, 48 and Figs. 26, 29, 32, 34, 36, 37, 44, 47, 51-53, also see col. 29, lines 18 to col. 33) of videos or audios recorded in the recording medium using the ID signals (Fig. 17, USER DEFINED PGC sequence and Fig. 27); and
- reproducing one or more videos or audios in the title list and reproduces sequentially part of each video or audio (see user defined chains, PGC videos/sections of video, see Fig. 27, PLAY LIST #1 comprises parts of program 1 and parts of program 3, that is play list # 1, also see #2 play list parts of 2 & 4).

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Regarding claim 14, Tsumagari discloses and meets the limitations associated with

- o sorting audio or video titles in order of:
- o date (Fig. 35, col. 30, lines 54-56); or
- o title; or
- o classification (reads on user defined play list and/or based on an attribute, such as Fig. 35, sorted by, "MARK REC DATE"); or
- o recording in response to a received user indication (col. 29, line 65 to col. 30, line 4, Fig. 35, see time column, increasing time, also see Mark Rec Dates with time, in sequence 1st-{99.01.02 16:00}, 2nd-{99.01.03 14:00} and 3rd-{99.01.03 15:00}), also see attribute column, "USER", user dictated entry points, being bookmarks (col. 29, line 66 to col. 30, line 7, "pause", creates bookmarks, user interaction).

The scope of claim 14 deems that only one limitation is required to meet the claim.

Regarding claim 15, Tsumagari discloses and meets the limitation of sorting the titles of the recorded video or audio that have been automatically recorded by a timer (either met by a recording timer for events {col. 25, lines

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54-60, "TIMER RECORDING", and/or col. 27, lines 10-15, "TIMER PLAYBACK" and/or col. 29, lines 25-55} or timer entry point generation, see Menu Fig. 35 and Play lists).

The user can change the order by PGC ordering (PLAY LIST) and the system includes a timer (col. 29, lines 17-20, "entry point at time intervals" or col. 27, lines 11-15, "timer", Fig. 35).

Regarding claim 17, Tsumagari discloses and meets the limitation of receiving a user indication of sorting the video or audio titles and sorting in accordance as users desires (Fig. 27, user created play lists of parts of multi-media material (video w/audio) recorded to the medium); and providing the sorted title list to the user (met by rendering the play list with the system or playback, Fig. 29, "48").

Regarding claim 18, Tsumagari discloses and meets the limitation of having thumbnail images for titles sorted (see Fig. 35, menu of titles/programs, having, "THUMBNAIL", images for each title).

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 16, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsumagari et al. (US 6,480,669).

Regarding claims 16 and 22, Tsumagari discloses and meets the limitation of user created play list of parts of multimedia and reproducing in accordance with parts that can be any portions of the video or audio material (Fig. 27).

Since the system is adapted to allow users can pick any parts of the titles to create desired a play back sequences {parts of title/program materials, play list, Fig. 27}, the examiner renders it obvious to create a sequence of parts corresponding to beginning parts of video or audio in the recorded titles/programs recorded to the medium, as an introduction playback sequence, which is a preview sequence operation of recorded material, the sequence showing what is recorded in a sequence of beginning section of recorded programs.

To reinforce the examiner's position of obviousness, since applicant Tsumagari had not specifically stated the idea of a sequence having beginning portions or parts of selected videos and audios or user generating, "AN INTRODUCTION PLAYBACK", in Fig. 27, Tsumagari suggests this operation,

see PLAYLIST #1, "having a beginning Part of Program 1";

and "having a beginning Part of Program #3".

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Therefore, it is deemed obvious if not inherent, that users with **Tsumagari in front of themselves**, can create,

"INTTRODUCTION PLAYBACK SEQUENCES", corresponding to BEGINNING PARTS OF RECORDED multimedia, in view of Fig. 27 and what is deemed obvious to those skilled in the art.

Upon user selection of an introduction playback being a predetermined amount of time corresponding to a beginning parts of the titles/programs recorded.

The system allows users to create sequential reproduction of parts that can be the beginning parts as desired as is obvious of not met by the applied art.

Claims 20, 21 and 23-24 are analyzed and discussed with respect to **Tsumagari supra**.

Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record Vincent F. Boccio whose telephone number is (571) 272-7373.

The examiner can normally be reached on between Monday thru Friday between (7:30 am to 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

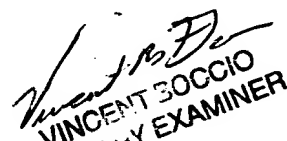
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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Primary Examiner, Boccio, Vincent
3/3/08


VINCENT BOCCIO
PRIMARY EXAMINER